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EXAMINER

ARSHAD, UMAR

ART UNIT	PAPER NUMBER
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2174

DATE MAILED: 04/08/2004

8

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/810,992

Applicant(s)

SHAOUY ET AL.

Examiner

Umar Arshad

Art Unit

2174

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 January 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

This communication is responsive to Amendment A, filed 1/27/2004.

Claims 1 – 20 are pending in this application. Claims 1, 8, and 18 are independent claims. In the Amendment A, claims 12 – 20 were added, and claim 4 was amended. This action is made Final.

Claim Rejections - 35 USC § 102

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1,2,4,6,8, 9 and 12 – 17 are rejected under 35 U.S.C. 102(e) as being anticipated by Kadowaki, U.S. Patent No. 6,313,921.

As per claim 1, Kadowaki teaches a method for tailoring information to characteristics of a information user, comprising the acts of:

a) passing a request object containing at least one profile element to an arbiter (see Kadowaki, column 18, lines 38 – 61; the examiner interprets the printer controller as an arbiter because it directs personalization information to a personalization server);

b) selecting a personalization engine from a plurality of personalization engines by the arbiter (see Kadowaki, column 15, lines 41 – 45);

c) accessing a content database to retrieve a personalized content object identified by the personalization engine selected by the arbiter (see Kadowaki, column 18, lines 63 – 67 and column 19, line 1; it is inherent that the personalization server must store and manage the personalizing information in a database if it is to extract said information for a particular user).

As per claim 2, which is dependent on claim 1, Kadowaki teaches the method of claim 1 (see rejection above). Kadowaki further teaches the method comprising the act of passing the personalized content object to an application program (see Kadowaki, column 19, lines 1 – 3).

As per claim 4, which is dependent on claim 1, Kadowaki teaches the method of claim 1 (see rejection above). Kadowaki further teaches the method comprising the act of sending the request object over a communication network (see Kadowaki, column 2, lines 25 – 30).

As per claim 6, which is dependent on claim 1, Kadowaki teaches the method of claim 1 (see rejection above). Kadowaki further teaches the method comprising the acts of:

d) accessing a profile database that stores profile elements associated with the request object (see Kadowaki, column 19, 51 – 67; it is inherent that the personalization information is stored in a database);

e) retrieving from the profile database at least one profile element associated with the request object (see Kadowaki, column 18, lines 63 – 67 and column 19, lines 1 – 11); and

f) including in the request object at least one profile element retrieved from the profile database (see Kadowaki, column 18, lines 38 – 67 and column 19, lines 1 – 11; it is inherent that the user ID sent in the request object is part of the user profile retrieved by the personalization server).

As per claim 8, Kadowaki teaches an apparatus for tailoring information to characteristics of an information user, the apparatus comprising:

a) an arbiter for accepting and analyzing a request object (see Kadowaki, column 18, lines 38 – 61; the examiner interprets the printer controller as an arbiter because it directs personalization information to a personalization server); and

b) a plurality of personalization engines for selecting at least one personalization object from a content database (see Kadowaki, column 15, lines 41 – 45);

wherein the arbiter selects a personalization engine from the plurality of personalization engines (see Kadowaki, column 18, lines 38 – 44), and the selected personalization engine selects at least one personalization content from the content database (see Kadowaki, column 18, lines 62 – 67, and column 19, lines 1 – 11).

As per claim 9, which is dependent on claim 8, Kadowaki further teaches the apparatus comprising output logic for passing at least one personalization content object to an application program over a communication network (see Kadowaki column 2, lines 25 – 30 and column 19, lines 1 – 3; it is inherent that the printer controller is an application program)

As per claim 12, which is dependent on claim 1, Kadowaki teaches the method of claim 1 (see rejection above). Kadowaki further teaches the method of claim 1, further comprising selecting a personalization engine using at least one of an object-oriented analysis and an expert-system analysis process (see Kadowaki, column 18, lines 39 – 46; the examiner interprets a printer controller as an expert-system).

As per claim 13 which is dependent on claim 12, Kadowaki teaches the method of claim 12 (see rejection above). Kadowaki further teaches the method of claim 12, wherein the expert-system analysis comprises at least one of rule based analysis, model based analysis, and knowledge based analysis (see Kadowaki, column 18, lines 39 – 46; the examiner interprets acquiring the network address of a personalization server as a part of user ID information as performing rule-based analysis).

As per claim 14 which is dependent on claim 1, Kadowaki teaches the method of claim 1 (see rejection above). Kadowaki further teaches the method of claim 1, further

comprising the arbiter analyzing at least one of a date of the request object, a user identity, a user shopping history, and a user usage path (see Kadowaki, column 18, lines 39 – 46).

As per claim 15 which is dependent on claim 8, Kadowaki teaches the method of claim 8 (see rejection above). Kadowaki further teaches the apparatus of claim 8, wherein the arbiter is configured to receive a request object from a user (see Kadowaki, column 3, lines 5 – 6) and a profile element from a profile database (see Kadowaki, column 19, lines 1 – 3).

As per claim 16, which is dependent on claim 8, it is of similar scope to claim 12 and is rejected under the same rationale as claim 12 (see rejection above).

As per claim 17, which is dependent on claim 8, it is of similar scope to claim 14 and is rejected under the same rationale as claim 14 (see rejection above).

Claims 18 – 20 are rejected under 35 U.S.C. 102(e) as being anticipated by Tetzlaff, U.S. Patent No. 6,556,963.

As per claim 18, Tetzlaff teaches a method for tailoring information delivered to a user, comprising:

an arbiter selecting a personalization engine (see Tetzlaff, column 3, lines 43 – 44; the examiner interprets the food analyzer as an arbiter); and

the personalization engine selecting a personalized content object to tailor information provided to the user (see Tetzlaff, column 3, lines 62 – 67).

As per claim 19, which is dependent on claim 18, Tetzlaff teaches the method of claim 18 (see rejection above). Tetzlaff further teaches the method of claim 18, further comprising the arbiter receiving a request object from a user (see Tetzlaff, column 3, lines 41 – 43), and sending the selected personalized content object to the user's application program (see Tetzlaff, column 3, lines 66 – 67).

As per claim 20, which is dependent on claim 19, Tetzlaff teaches the method of claim 19 (see rejection above). Tetzlaff further teaches the method of claim 19, further comprising the arbiter receiving a profile element from a profile database (see Tetzlaff, column 3, lines 58 – 61; it is inherent that the search engines search databases).

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 3, 5, 10 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kadowaki, U.S. Patent No. 6,313,921 in view of Kurtzman, II, U.S. Patent No. 6,044,376.

As per claim 3, which is dependent on claim 2, Kadowaki teaches the method of claim 2 (see rejection above). Kadowaki does not teach the method wherein the application program is a web browser. Kurtzman, II teaches the method wherein the application program is a web browser (see Kurtzman, II, column 3, lines 32 – 37, and column 3, lines 60 – 67; it is taught that the user communicates to the web server via a web browser, and it is inherent that when the personalized content is delivered to the user it is viewed via said web browser). It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the method taught by Kurtzman, II with the method taught by Kadowaki to provide a more sophisticated profiling technique for use in a web browser.

As per claim 5, which is dependent on claim 4, Kadowaki teaches the method of claim 4 (see rejection above). Kadowaki does not teach the method wherein the communication network is the Internet. Kurtzman, II teaches the method wherein the communication network is the Internet (see Kurtzman, II, column 3, lines 32 – 37, and column 3, lines 60 – 67).

As per claim 10, which is dependent on claim 9, Kadowaki teaches the method of claim 9 (see rejection above). Kadowaki does not teach the method wherein the communication network is the Internet. Kurtzman, II teaches the method wherein the communication network is the Internet (see Kurtzman, II, column 3, lines 32 – 37, and column 3, lines 60 – 67).

As per claim 11, which is dependent on claim 9, Kadowaki teaches the method of claim 9 (see rejection above). Kadowaki does not teach the method wherein the application program is a web browser. Kurtzman, II teaches the method wherein the application program is a web browser (see Kurtzman, II, column 3, lines 32 – 37, and column 3, lines 60 – 67; it is taught that the user communicates to the web server via a web browser, and it is inherent that when the personalized content is delivered to the user it is viewed via said web browser). It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the method taught by Kurtzman, II with the method taught by Kadowaki to provide a more sophisticated profiling technique for use in a web browser.

Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kadowaki, U.S. Patent No. 6,313,921 in view of Jacobi et al., U.S. Patent No. 6,064,980 and Tetzlaff, U.S. Patent No. 6,556,963.

As per claim 7, which is dependent on claim 1, teach the method of claim 1 (see rejection above). Kadowaki does not teach the method wherein the plurality of personalization engines comprises at least two personalization engines selected from the group consisting of a rule-based personalization engine, a predictive-modeling personalization, and a collaborative filtering personalization.

Jacobi et al. teaches a collaborative filtering engine (see Jacobi et al., column 2, lines 18 – 21; the examiner interprets the recommendation service as a personalization engine because it uses collaborative filtering using particular user information to recommend items to users).

Tetzlaff teaches a rule-based personalization engine (see Tetzlaff, column 2, lines 22 – 27; the examiner interprets the feedback generator as a personalization engine because it uses rule-based protocol to give feedback to a user depending on a particular user model).

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the personalization engines as taught by Jacobi et al. and Tetzlaff with the method of Kadowaki in order to provide more options from which to select personalization from.

Response to Arguments

Applicant's arguments filed on 1/27/2004 have been fully considered but they are not persuasive.

Applicant argued the following:

(a) Kadowaki does not anticipate the claimed invention because it does not select a personalization engine, and it does not use the personalization engine to identify and retrieve a personalized content object.

(b) Kadowaki does not first select a personalization engine and then use that personalization engine to access a database to further select personalized information.

(c) Kadowaki does not teach retrieving from a profile database profile elements associated with the request object, and including the profile element in the request object.

(d) The user ID linking process by Kadowaki does not use any information beyond the user ID for identifying image forming information and acquiring set-up information.

(e) The Kadowaki printer controller is not an arbiter which directs personalization information to a personalization server. The printer controller does not engage in a selection process by analysis and selection based on multiple variables as used in the invention.

(f) The Kadowaki process is not an analysis and selection process resulting in a decision by distilling multiple pieces of information as used by the invention, nor is the

Kadowaki process carried out by an arbiter capable of refining or altering its selection based on multiple pieces of information as used in the invention.

The Examiner disagrees for the following reasons:

Per (a) the examiner interprets using “user ID information” to “indicate a personalizing server from which personalization information is to be acquired” (Kadowaki, column 15, lines 45 – 53) as selecting a personalization engine. Also, Kadowaki clearly teaches that the personalization server extracts “personalizing information” based on the “user ID information and the like” (Kadowaki, column 18, line 62 – column 19, line 3). Therefore, Kadowaki clearly teaches selecting a personalization engine, and using the personalization engine to identify and retrieve a personalized content object.

Per (b) Kadowaki teaches using “user ID information” to “indicate a personalizing server from which personalization information is to be acquired” (Kadowaki, column 15, lines 45 – 53). Kadowaki further teaches that the network address of the personalization server is acquired as part of user ID information of a print job (Kadowaki, column 18, lines 44 – 46). Finally, Kadowaki teaches that the personalization server whose network address is acquired by the user ID information extracts “personalizing information managed by itself and stored for an apparatus of the user” based on the “user ID information and the like” sent from the printer controller (Kadowaki, column 18, line 62 – column 19, line 3). It is inherent that the personalizing information is stored in a database because it is stored and managed by the

personalization server and is uniquely identified by unique user ID information and the like. Therefore, Kadowaki clearly teaches first selecting a personalization engine and then using that personalization engine to access a database to further select personalized information.

Per (c) Kadowaki teaches that the personalization information contains "a cumulative number of printed sheets of the current user, an upper-limit number of printed sheets of the current user, an available function list of the current user, font data of the current user, cover sheet image data of the current user, and form image data of the current user" (Kadowaki, column 19, lines 3 – 10). The examiner interprets all of these to be profile elements associated with the request object. Kadowaki further teaches accomplishing personalization by copying the supplied information to the printer controller storage (Kadowaki, column 19, lines 10 – 12). The examiner interprets this as including the profile element in the request object. Therefore, Kadowaki clearly teaches retrieving from a profile database profile elements associated with the request object, and including the profile element in the request object.

Per (d) the argued limitation is not reflected in the claim language of any of claims 1, 2, 4, 6 or 8.

Per (e) Kadowaki teaches using "user ID information" to "indicate a personalizing server from which personalization information is to be acquired" (Kadowaki, column 15, lines 45 – 53). Kadowaki further teaches that the printer controller acquires the network address of the personalizing server from the user ID information described in a print job and sends the user ID information to the selected personalizing server (Kadowaki,

column 18, lines 39 – 46). The examiner interprets the user ID information to be request information because it specifies the user who requested the personalizing. Therefore Kadowaki clearly teaches that the printer controller selects a personalizing server based on request information and passes this request information to the personalizing server. The argued limitation of “a selection process by analysis and selection based on multiple variables” is not reflected in the claim language of any of claims 1, 2, 4, 6, or 8.

Per (f) the argued limitations are not reflected in the claim language of any of claims 1, 2, 4, 6, or 8.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

Art Unit: 2174

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Umar Arshad whose telephone number is (703) 305-0329. The examiner can normally be reached on Monday - Friday, 9am - 5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kristine L Kincaid can be reached on (703) 308-0640. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

UA

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